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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/037,535	03/10/98	KUBLER	J DN37998XGA

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EXAMINER	
FELBER, J	
ART UNIT	PAPER NUMBER
2732	4
DATE MAILED:	08/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/037,535

Applicant(s)

Kubler et al.

Examiner

Joseph L. Felber

Group Art Unit

2732



Responsive to communication(s) filed on Mar 10, 1998.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 22-34 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 22-34 is/are rejected.

Claim(s) 28-34 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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*Specification*

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The specification is objected to because of the following informalities:

The specification does not contain pages numbered "33", "51", and "270". (If applicants believe the parent application provides support for a subsequent amendment adding the missing pages, applicants should state that position explicitly.)

On p. 9, line 7, it appears that --offer-- should replace "often".

Page 40, in line 9, refers to a "Fig. 55", but the application only has figs. "55a" and "55b".

Page 58, in line 22, refers to a "Fig. 7", but the application only has figs. "7a" and "7b".

Page 60, in line 5, refers to a "Fig. 20B", but the application only has figs. "20b-1" and "20b-2".

Page 73, in line 7, refers to an abandoned application as "pending".

Reference numeral "3035" if fig. 28C was not found defined in the specification.

Page 180, bottom line, refers to an application as "pending", which is incorrect.

Lines 3 and 4 of p. 310 state that element 6307 of fig. 63 is an Internet "provider", but fig. 63 labels box 6307 "Internet routing".

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***Claim Objections***

- JfS* 3. Claims 28-34<sup>are</sup> objected to because, in claims 28 and 29 (lines 1 of each), it seems that --the-- should precede "Internet".

***Claim Rejections - 35 USC § 102***

4. The effective priority date for the pending claims is 10/5/95. This is the filing date of parent application 08/539,817 (now U.S. Patent No. 5,726,984). The parent application was a CIP adding the material that supports the pending claims.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 22-25, 27, and 28 are rejected under 35 U.S.C. § 102(e) as being anticipated by DuVal (U.S. Patent No. 5,818,836).

*Regarding claims 22, 27, and 28:*

Fig. 8 teaches a "telephone" (combination telephone station 20 and AVS 14A). Since telephone station 20 may be an ordinary telephone, col. 5, line 24, it has a "microphone" and a

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"user interface". AVS 14A serves as an "interface circuit" and "processing circuitry". The telephone is capable of communicating through a first network having predetermined allocated bandwidth (circuit switched network 12, which may be the public switched telephone network, col. 5, lines 65-67) or through a second network having a variable bandwidth (switched packet network 16, preferably the Internet, col. 20, lines 3-5). These two networks are substantially independent of one another. Since the signal produced by the microphone of an ordinary telephone is analog and the Internet accommodates digital signals, there is inherently an analog-to-digital converter coupled between the microphone and the second network.

(Note also that the reference explicitly teaches that AVS 14A and AVS 14B may communicate over packet switched network 16. Col. 20, lines 7-9. Also, since the reference diagrammatically represents the hanging up of a call by path 903 through circuit switched network 12 in fig. 8, it implies that AVS 14A and AVS 14B may also communicate over circuit switched network 12.)

*Regarding claims 23-25:*

Fig. 8 shows two parties communicating with each other. Col. 20, lines 52-55. Since telephone station 20 may be an ordinary telephone, it uses a "telephone number" as the alphanumeric sequence to establish the communication.

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***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

*34*  
8. Claims 22-~~29~~<sup>1</sup> are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of U.S. Patent No. 5,726,984. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in scope. (In other words, it would not be tenable to restrict the conflicting claims from each other if they had been filed in the same application.)

The patented claim 20 covers a telephone that can be described by the portions of the specification that support that claim. Those portions by and large are what is covered by the pending claims, and issuing the new claims without a terminal disclaimer would effectively lengthen the patent term of patented claim 20 beyond the statutory time period.

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***Allowable Subject Matter***

9. With a terminal disclaimer, claim 26 would be allowable if rewritten in independent form including all of the limitations of base claim 22. This is because no teaching was found in DuVal for the user interface determining which network to select.

*J.L.F.*  
With a terminal disclaimer, claims 29-<sup>74</sup>~~32~~ would be allowable if claim 29 were rewritten to overcome the rejection due to form (detailed above). This because claim 29 describes a network telephone coupled to the Internet with processing circuitry directing the storage of voice information into a buffer for a queuing period corresponding to Internet propagation delay. As noted above, DuVal teaches much of the claimed invention; however, it does not teach the claimed queuing period. Queuing periods bearing the claimed relationship with propagation delays were known in the art in ATM networks, and Esaki (U.S. Patent No. 5,850,385), in col. 7, lines 40-62, teaches such an example. DuVal teaches that packet switched network 16 may be the Internet or an ATM network. Since claim 29 is specifically limited to communication through the Internet, there would need to be some suggestion to apply the ATM teachings for use with the Internet to render claim 29 obvious. Since no such teaching was found, the references do not render the claims obvious and are therefore allowable.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph Felber, whose telephone number is 703-305-4933.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Douglas Olms, can be reached at 703-305-4703.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist, whose telephone number is 703-305-3900.



Joseph L. Felber, Primary Examiner  
August 23, 2000